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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/631,583	08/03/2000	Gad Liwerant	VIDS-0001-P02	9242

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STRATEGIC PATENTS P.C..
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EXAMINER	
SALTARELLI, DOMINIC D	

ART UNIT	PAPER NUMBER
2623	

DATE MAILED: 07/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/631,583	LIWERANT ET AL.	
	Examiner	Art Unit	
	Dominic D. Saltarelli	2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *17 May 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-12 and 36-40* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-12 and 36-40* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 17, 2006 has been entered.

Response to Arguments

Applicant's arguments with respect to claims 1-12 have been considered but are moot in view of the new grounds of rejection. Regarding claim 1, the "sender" has been reinterpreted to refer to the computer system which sends video data to a recipient in light of applicant's amendment.

Claim Objections

2. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 29-33 been renumbered 36-40.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-3 are rejected under 35 U.S.C. 102(e) as being anticipated by Hjelsvold et al. (6,546,555, of record) [Hjelsvold].

Regarding claim 1, Hjelsvold discloses a method of sending a video segment and an associated advertisement over a computer network (customers select and view video segments sent from a server, col. 2, line 58 – col. 3 line 8, wherein the video segments are streamed to customers with associated advertisements, col. 8, lines 56-65 and col. 12, lines 15-34), comprising:

(a) acquiring a video segment at a computer system (col. 6, lines 61-64);

(b) acquiring advertisements (promotional video inserts) at the computer system (in order to insert said promotional inserts, they must first be acquired by the system, col. 12, lines 15-34);

(c) offering to a sender an opportunity to indicate a selection of an advertisement of the advertisements to be associated with the video segment (the filtering service will select advertisements automatically according to selection parameters, which are set by the merchant, col. 6, lines 14-19, wherein

the sender is offered the opportunity to select an ad when a video is selected by a requesting user, col. 5, lines 14-51);

(d) accepting from the sender the indication of a selection of the advertisement to be associated with the video segment (col. 8, lines 56-65); and

(e) directly in response to the indication accepted in step (d), automatically at the computer system:

(i) assuring that the video segment is in a streaming format (col. 8 line 66 – col. 9 line 33);

(ii) creating an identifier for the video segment (an inherent feature, as the computer network in question is the internet, col. 2, lines 58-60, thus the video segment is a file which has identification information associated with it prior to transmission over the internet to the receiving computer);

(iii) associating the video segment and the advertisement (col. 8, lines 56-65 and col. 12, lines 15-34); and

(iv) sending the video segment, the identifier, and the associated advertisement over the computer network to a receiving computer system (col. 9, lines 34-44).

Regarding claim 2, Hjelsvold discloses the method of claim 1, wherein the step of offering to a sender an opportunity to indicate a selection of an advertisement of the advertisements includes a criterion selectable by the sender

(the filtering service uses parameters and selection rules for automatically selecting among available promotional sequences, col. 12, lines 21-34).

Regarding claim 3, Hjelsvold discloses the method of claim 2, wherein the criterion is the length of the advertisement (the filtering parameters include the length of the promotional sequence, as this is a factor considered when selecting promotional sequences for insertion into a video segment, col. 5, lines 14-51, specifically lines 29-33).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hjelsvold.

Regarding claims 4-6, Hjelsvold discloses the method of claims 1 and 2, but fails to disclose the step of offering to a sender an opportunity to indicate a selection of an advertisement includes a randomized default selection if the sender fails to indicate a selection.

The official notice taken that it is notoriously well known in the art to rely upon a randomized selection of necessary data in the absence of user input

specifying a particular data was not traversed by the applicant, and is thus taken as an admission of the facts herein.

It would have been obvious at the time to a person of ordinary skill in the art to modify the method disclosed by Hjelsvold to include a randomized default selection if the sender fails to indicate a selection, for the benefit of maintaining continuous and proper execution of the system in the event that a human user either purposely or inadvertently does not specify advertisement selection criterion, without displaying the same promotional video [advertisement] too often.

7. Claims 7-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hjelsvold in view of Ellis et al. (6,774,926, of record) [Ellis] and Rothschild (US 2001/0047294 A1).

Regarding claim 7, Hjelsvold discloses a method of sending a video segment and an associated advertisement over a computer network (customers select and view video segments sent from a server, col. 2, line 58 – col. 3 line 8, wherein the video segments are streamed to customers with associated advertisements, col. 8, lines 56-65 and col. 12, lines 15-34), comprising:

(a) acquiring a video segment at a computer system (col. 6, lines 61-64);

(b) selecting, by the sender, an advertisement stored at the server computer system (the merchant may statically define which promotional video sequences are inserted into the video segments, col. 12, lines 21-34); and

(c) in response to receiving an indication as to which advertisement to associate with the video (col. 8, lines 56-65 and col. 12, lines 15-34), the server computer system automatically:

(i) assures that the video segment is in a streaming format (col. 8 line 66 – col. 9 line 33);

(ii) creates an identifier for the video segment (an inherent feature, as the computer network in question is the internet, col. 2, lines 58-60, thus the video segment is a file which has identification information associated with it prior to transmission over the internet to the receiving computer);

(iii) associates the video segment and the advertisement (col. 12, lines 15-34); and

(iv) sends the video segment, the identifier, and the associated advertisement over the computer network to a receiving computer system (col. 9, lines 34-44).

Hjelsvold fails to disclose uploading a video segment from a sender computer system to the server computer system and transmitting from the sender computer to the server computer system an indication of the selected advertisement.

In an analogous art, Ellis teaches uploading a video segment from a sender computer system to a server computer system (col. 3 line 55 – col. 4 line 4 and col. 7, lines 38-48), allowing smaller entities, such as home users, to create and provide video content (col. 3, lines 19-29).

It would have been obvious at the time to a person of ordinary skill in the art to modify the method disclosed by Hjelsvold to include uploading a video segment from a sender computer system to the server computer system, as taught by Ellis, for the benefit of allowing smaller entities, such as home users, to create and controllably provide video content, such as personalized, or special interest, content.

Hjelsvold and Ellis fail to disclose transmitting from the sender computer to the server computer system an indication of the selected advertisement.

In an analogous art, Rothschild discloses allowing users to personally designate which advertisements are associated with uploaded content intended for transmission to another (paragraph 50), allowing home users to be compensated for associating ads with uploaded content (paragraph 56).

It would have been obvious at the time to a person of ordinary skill in the art to modify the method disclosed by Hjelsvold and Ellis to include transmitting from the sender computer to the server computer system an indication of the selected advertisement, as taught by Rothschild, for the benefit of allowing home users [the sender] to be compensated for associating ads with uploaded content which is transmitted to the recipient upon selection of an advertisement.

Regarding claim 8, Hjelsvold, Ellis, and Rothschild disclose the method of claim 7, wherein selecting an advertisement comprises using a criterion chosen by an operator of the sender computer system (Hjelsvold teaches the filtering

service uses parameters and selection rules for automatically selecting among available promotional sequences, col. 12, lines 21-34, wherein said parameters are set by the merchant, col. 6, lines 14-19).

Regarding claim 9, Hjelsvold, Ellis, and Rothschild disclose the method of claim 8, wherein the criterion is the length of the advertisement (Hjelsvold teaches the filtering parameters include the length of the promotional sequence, as this is a factor considered when selecting promotional sequences for insertion into a video segment, col. 5, lines 14-51, specifically lines 29-33).

Regarding claims 10 and 11, Hjelsvold, Ellis, and Rothschild disclose the method of claim 8, wherein said criterion includes leaving said selection to the determination of said server computer system which selects the advertisement in a substantially randomized manner (Rothschild, paragraph 52).

8. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hjelsvold, Ellis, and Rothschild as applied to claim 10 above, and further in view of Eldering et al. (6,820,277) [Eldering].

Regarding claim 12, Hjelsvold, Ellis, and Rothschild disclose the method of claim 10, but fail to disclose said selection is based on a price paid by an advertiser.

In an analogous art, Eldering discloses providing advertisers the opportunity to bid upon advertisement opportunities, awarding the advertisement time slot to the highest bidder (col. 8 line 63 – col. 9 line 12).

It would have been obvious at the time to a person of ordinary skill in the art to modify the method disclosed by Hjelsvold, Ellis, and Rothschild to select an advertisement based on a price paid by an advertiser, as taught by Eldering, for the benefit of allowing advertisers to bid upon advertisement opportunities, maximizing the advertising revenues generated by the server computer system.

9. Claims 36-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rothschild in view of "Streaming Email" (XP-002150023, supplied by applicant).

Regarding claim 36, Rothschild teaches a method for operating a video-sharing server on a network comprising:

storing a plurality of advertisements (paragraph 64); and

receiving from a client a video, an electronic email address, and a selection of one of the plurality of advertisements (paragraph 57, wherein the email is a video message, paragraph 48).

Rothschild fails to disclose confirming that the video is in streaming format, storing the video at a network-accessible location, generating an identification tag including a link to the network accessible location, generating an electronic communication containing the link and addressed to the electronic email address, and transmitting the electronic communication.

In an analogous art, "Streaming Email" teaches sending video email messages in streaming format by creating a pointer included in a text email message sent to a designated recipient which points to the network accessible location where the video has been stored in said streaming format (pgs. 308-313, "Video Express Email"), providing the benefit of sharing video messages with others that does not require transmission of the full video along with the email.

It would have been obvious at the time to a person of ordinary skill in the art to modify the method disclosed by Rothschild to include sending video email messages in streaming format by creating a pointer included in a text email message sent to a designated recipient which points to the network accessible location where the video has been stored in said streaming format, as taught by "Streaming Email" for the benefit of sharing video messages with others that does not require transmission of the full video along with the email.

Regarding claim 37, Rothschild and "Streaming Email" disclose the method of claim 36, wherein receiving the video includes receiving an HTTP post (Rothschild teaches the email is assembled and transmitted via interactions with web site 110, paragraph 48).

Regarding claim 38, Rothschild and "Streaming Email" disclose the method of claim 36, but fail to disclose publishing the link to a Web page.

The examiner takes official notice that publishing links to videos in web pages is notoriously well known in the art.

It would have been obvious at the time to a person of ordinary skill in the art to modify the method of Rothschild and "Streaming Email" to include publishing the link to a Web page.

Regarding claim 39, Rothschild and "Streaming Email" disclose the method of claim 36, further comprising receiving a mailing list including a plurality of email addresses and transmitting the electronic message to the plurality of email messages (Rothschild teaches sending a single message to multiple recipients at once, paragraph 53).

Regarding claim 40, Rothschild and "Streaming Email" disclose the method of claim 36, wherein the link includes a path ("Streaming Email" teachings sending a pointer file which designates the location of the file for streaming, page 308).

Conclusion

10. The following are suggested formats for either a Certificate of Mailing or Certificate of Transmission under 37 CFR 1.8(a). The certification may be included with all correspondence concerning this application or proceeding to establish a date of mailing or transmission under 37 CFR 1.8(a). Proper use of this procedure will result in such communication being considered as timely if the established date is within the required period for reply. The Certificate should be signed by the individual actually depositing or transmitting the correspondence or by an individual who, upon information and belief, expects the correspondence to be mailed or transmitted in the normal course of business by another no later than the date indicated.

Certificate of Mailing

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to:

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on _____.
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Typed or printed name of person signing this certificate:

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Certificate of Transmission

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office, Fax No. (703)_____ - _____ on _____.
(Date)

Typed or printed name of person signing this certificate:

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Signature: _____

Registration Number: _____

Please refer to 37 CFR 1.6(d) and 1.8(a)(2) for filing limitations concerning facsimile transmissions and mailing, respectively.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dominic D. Saltarelli whose telephone number is (571) 272-7302. The examiner can normally be reached on Monday - Friday 7:00am - 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on (571) 272-7353. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Dominic Saltarelli
Patent Examiner
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DS

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